

## REMARKS

Claims 1, 2, 5 and 7-23 are pending in the present application and each stand rejected by the outstanding Office Action dated April 3, 2008. By this paper Applicants, add new claims 24-27. No new matter has been introduced by this amendment. Applicants respectfully request reconsideration of the claims in view of the following remarks.

### **Obviousness Rejection**

Claims 1-2, 5, 7-9, 12-17 and 19-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,679,938, issued to Templeton *et al.* (hereinafter "*Templeton*"), in view of U.S. Patent No. 4,658,126, issued to May (hereinafter "*May*"). Applicants respectfully traverse this rejection because the proposed combination fails to teach or suggest each and every feature recited in the pending claims.

Regarding claim 1, neither *Templeton* nor *May*, alone or in combination, teach or suggest "upon an indication that the negotiable instrument is *not authorized* for encashment, *automatically printing a mark on a document* using a printer in communication with the terminal, wherein the mark corresponds with the sign and *indicates that the negotiable instrument is not authorized for encashment*," as recited in the claim. The Office expressly states that *Templeton* fails to teach the aforementioned feature. (Office Action, p. 3.) Contrary to the Office's contention, however, *May* fails to cure the deficiencies of *Templeton*.

To this end, *May* is directed to a device for transferring imagery of a payer's ID card (*e.g.*, driver's license, state ID cards, etc.) to the back of a personal check before it is accepted by a payee. (Abstract; col. 2, ll. 60-63.) *May* merely discloses that once the payee has passed the check onto the payee's bank, and there exists inadequate funds to pay the check, the bank returns the check to the payee and indicates that insufficient funds are available. (Col. 2, ll. 63-68.) Thus, *May* does not disclose the aforementioned feature of "upon an indication that the negotiable instrument is *not authorized* for encashment, *automatically printing a mark on a document* using a printer in communication with the terminal, wherein the mark corresponds with

the sign and *indicates that the negotiable instrument is not authorized for encashment*," as recited in claim 1.

Because *Templeton* and *May* only disclose "displaying" or "indicating" that a check is not authorized, they fail to teach each and every feature as recited in claim 1, which is fatal to an obviousness determination. Accordingly, reconsideration and withdrawal of the rejection of claim 1 and associated dependent claims under 35 U.S.C. § 103(a) for at least the reasons set forth above is respectfully requested.

Claims 2, 5, 7-11 and 21-23 are dependent claims allowable for at least the same reasons as their respective base claim and further do to the additional features they recite. Separate and individual consideration of the dependent claims is respectfully requested.

With regard to independent claim 12, a method for authorizing a previously issued negotiable instrument for encashment is provided and recites the feature of "*automatically printing processing instructions* on the negotiable instrument if the sign indicates that the negotiable instrument is *not authorized* for encashment." Contrary to the Office's contention, the proposed combination of *Templeton* and *May* fails to teach or suggest the aforementioned feature.

Applicants agree with the Office's statement that *Templeton* does not teach the aforementioned feature of "automatically printing processing instructions on the negotiable instrument if the sign indicates that the negotiable instrument is not authorized for encashment." (See Office Action, p. 6.) The Office Action further states that *May* "teaches returning a negotiable instrument to a payee with an indication of insufficient funds." *Id.* This "teaching," relied upon in making the obviousness rejection, fails to address the deficiencies of *Templeton*. Specifically, *May* fails to cure the deficiencies of *Templeton* because *May* does not disclose "automatically printing processing instructions" on a negotiable instrument not authorized for encashment. Rather, as the Office states, *May* merely discloses indicating insufficient funds are available. *May* does not even disclose providing processing instructions, much less automatically printing them on a negotiable instrument if the instrument is not authorized for encashment.

Accordingly, reconsideration and withdrawal of the rejection of claim 12 under 35 U.S.C. § 103(a) for at least the reasons set forth above is respectfully requested.

Independent claim 13 is directed to a system for processing a previously issued negotiable instrument and includes features substantially similar to claim 1. For example, claim 13 expressly recites the feature of "a printing device in communication with the terminal that *automatically prints a mark on a document* upon an indication that the negotiable instrument is not authorized for encashment, wherein the mark corresponds with the sign and *indicates that the negotiable instrument is not authorized for encashment.*" Thus, the rejection of claim 13 is improper for at least the same reasons set forth above with respect to claim 1. Accordingly, reconsideration and withdrawal of the rejection of claim 13 and associated dependent claims under 35 U.S.C. § 103(a) is respectfully requested.

Associated dependent claims 14-19 are allowable for at least the same reasons as their respective base claim and further do to the additional features they recite. Separate and individual consideration of the dependent claims is respectfully requested.

Similarly, independent claim 20 is directed to system for authorizing a previously issued negotiable instrument for encashment and includes features substantially similar to claim 12. For example, claim 20 expressly recites the feature of "a printing device in communication with the terminal for automatically printing the sign on the negotiable instrument, the printing device further being operative to *automatically print the processing instructions* on the negotiable instrument if the negotiable instrument is *not authorized* for encashment." Thus, the rejection of claim 20 is improper for at least the same reasons set forth above with respect to claim 12. Accordingly, reconsideration and withdrawal of the rejection of claim 20 under 35 U.S.C. § 103(a) is respectfully requested.

### **New Claims**

New claims 24-27 have been added for consideration by the Examiner. Because claims 24-27 are dependent claims associated with independent claim 1, which is believed to be

allowable as discussed above, claims 24-27 are also believed to be allowable based upon this dependency and further due to the additional features they recite.

**CONCLUSION**

In view of the foregoing, Applicants respectfully submit that the independent claims patentably define the present invention over the citations of record. Further, the dependent claims should also be allowable for the same reasons as their respective base claims and further due to the additional features that they recite. Separate and individual consideration of the dependent claims is respectfully requested. Applicants believe that all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested.

The Petition fee of \$120 along with the additional claims filing fee of \$200 is being charged to Deposit Account No. 02-3978 via electronic authorization submitted concurrently herewith. The Commissioner is hereby authorized to charge any additional fees or credit any overpayments as a result of the filing of this paper to Deposit Account No. 02-3978.

Respectfully submitted,

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